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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,646	11/24/2003	Heini Zollinger	0115-032131	4696

28289 7590 04/29/2005

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EXAMINER
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PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/720,646

Applicant(s)

ZOLLINGER, HEINI

Examiner

Frederick J. Parker

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-23 is/are pending in the application.  
4a) Of the above claim(s) 17-20 and 23 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 11-16, 21 and 22 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2-17-04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Election/Restrictions***

2. Applicant's election with traverse of claims 11-16,21-22 in the reply filed on 3/4/05 is acknowledged. The traversal is on the ground(s) that Applicants argue (1) chemical embossing would not produce the same product, (2) the wording of the method and article claims "share virtually identical language", and (3) there is no issue of "undue burden" because there would be the same search for both sets of claims. This is not found persuasive because for (1) Applicants simply fail to provide evidence or rationale to support that non-mechanical means would not produce the same product. (2) the fact that the wording of the method and product by process have similar wording is irrelevant because patentability of the article is based upon resultant structure, not the manipulation of forming steps, MPEP 2113. (3) in view of the response to (2), there would not be any coextensive or overlapping search, hence one type of undue burden exists. Furthermore, the issues related to examination and allowance of product claims (CL 428) would be different and unfamiliar to an Examiner of method claims (CL 427), thereby posing an additional undue burden to the Examiner far and beyond that of additional search.

Since the previous Examiner properly cited a materially different process by which the article could be made, and Applicants have failed to provide evidence or rationale to rebut the position, and the claim fails to provide any structural limitations by which to persuade this Examiner

Art Unit: 1762

otherwise, the restriction was appropriate. The requirement is still deemed proper and is therefore made FINAL.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1762

4. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 11 is vague and indefinite because it is unclear how a surface can be “jointless” (includes edges) since it would therefore be infinite; the claim is further vague and indefinite because the term “sheetlike” fails to clearly define the intended surfacing, and further the term “like” renders scope unascertainable since it encompasses unknown surfacing types beyond those which are “sheets”, and “sheetlike” is not defined nor a term recognized by the skilled artisan.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 1762

7. Claims 11-13,16,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portin US 4082888 in view of Bull US 4897302 and further in view of Burley US 6021646.

Portin teaches making durable, cushioned surfaces for sports fields, playgrounds, etc in which a mixture of rubber particles and a latex solution is applied to a base surface. The particles are deformable, resilient rubber with a particle size of between about 0.1-6mm, which encompasses the ranges of claims 12 and 21. The mixture is applied, and smoothed by spreader 27, to form a desired thickness of layer 31 on base 29, and further necessarily causes at least some degree of compaction from the applied pressure. Porosity and texturing by embossing are not disclosed.

Bull teaches on col. 2, 5-25 the use of a porous structure made of a mixture of liquid (polyurethane) polymer and rubber particles (0.5-5 mm), the structure containing porous interstices to provide resiliency, and the advantage of improved grip on athletic surfaces. Texturing by mechanical embossing is not disclosed.

Burley teaches making flooring systems for sports facilities, and includes teaching that top surfaces may be provided with a textured finish using a heated roller or texture wheel embossing means, without limitation on the regularity of textures formed. The texturizing is stated to enhance traction of persons walking or running on the surfaces.

All three references deal with the same subject matter: forming surfaces for sporting or related use with stated improvements as motivation to make the modifications. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Portin by substituting the porous formulation of Bull for that of Portin, and further mechanically texturizing the resultant surface as taught by Burley et al to provide the recognized

Art Unit: 1762

improvements of enhanced resiliency and grip/ traction of persons walking or running on the surfaces.

8. Claims 14,15,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portin US 4082888 in view of Bull US 4897302 and further in view of Burley US 6021646 ( hereafter "Previous Prior Art") and further in view of Slosberg et al US 3267187.

The Previous Prior Art is cited for the same reasons previously discussed, which are incorporated herein.

Slosberg et al also teaches applying rubber granules in a thermoplastic matrix, which may be subsequently calendared (suggesting the use of heated or ambient rollers), embossing, hot pressing, etc which are obvious alternative means to the texturizing means of Burley to provide surface texture.

Heated screed and rollers for compacting and texturizing are not explicitly cited. However, it is the Examiner's position that since Portin teaches spreader/ smoothing means and Slosberg et al teaches additional heated and unheated texturizing means, it would have been obvious to use other and known, functionally equivalent means such as a heated screed to provide the equivalent outcome, absent a clear and convincing showing to the contrary.

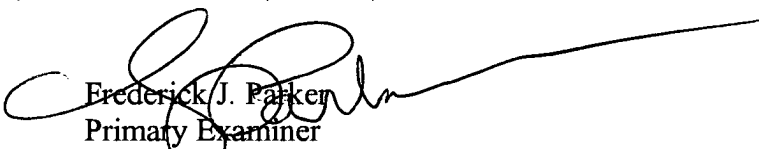
It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process of the Previous Prior Art by substituting the texturizing means of Slosberg et al for those of Burley et al because of the expectation of forming a texturized surface with enhanced grip/ traction of persons walking or running on the surface.

Art Unit: 1762

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frederick J. Parker  
Primary Examiner  
Art Unit 1762

fjp